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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.         | CONFIRMATION NO. |
|--|-------------|----------------------|-----------------------------|------------------|
| 10/701,193   | 11/04/2003  | Osamu Kurosawa       | 8305-234US<br>(NP61-0002-1) | 6237             |
| 570 7590 04/09/2008<br>PANITCH SCHWARZE BELISARIO & NADEL LLP<br>ONE COMMERCE SQUARE<br>2005 MARKET STREET, SUITE 2200<br>PHILADELPHIA, PA 19103 |             |                      |                             |                  |
| EXAMINER   |             |                      |                             |                  |
| LANG, AMY T  |             |                      |                             |                  |
| ART UNIT   |             | PAPER NUMBER         |                             |                  |
| 3731   |             |                      |                             |                  |
| MAIL DATE  |             | DELIVERY MODE        |                             |                  |
| 04/09/2008   |             | PAPER                |                             |                  |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/701,193

**Applicant(s)**

KUROSAWA ET AL.

**Examiner**

AMY T. LANG

**Art Unit**

3731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. **Claims 1-3** are rejected under 35 U.S.C. 103(a) as being unpatentable over Carrick (US 6,583,092 B1) in view of Komiya (US 2001/0044389 A1).

Carrick discloses a lubricating composition comprising base oil, specifically mineral oil of the paraffinic and naphthenic type, and a specific amount of phosphorus and sulfur (column 4, lines 51-56). The total amount of phosphorus in the composition is disclosed as 0.03 or 0.035 wt% (column 3, lines 49-60) and the total amount of sulfur is 0.07 wt% (column 3, lines 17-25), which clearly overlaps the instant claims. Carrick further discloses viscosity index improvers, including polymethacrylates having a molecular weight from 20,000 to 500,000 (column 23, lines 15-30). Friction modifiers including molybdenum dithiocarbamate are also present in the composition (column 25,

lines 15-17). The final lubricating composition comprises a kinematic viscosity from 5 to 16.3 mm<sup>2</sup>/s at 100 degrees Celsius, which clearly overlaps the instant claims (column 3, lines 8-11).

However, Carrick does not specifically disclose the kinematic viscosity and %Cp of the mineral oil.

Carrick discloses a final kinematic viscosity of the composition from 5 to 16.3 mm<sup>2</sup>/s at 100 degrees Celsius. This composition comprises mineral oil and a viscosity index improver up to 10 wt% (column 23, lines 54-60). Therefore, it is the examiner's position that a sufficient amount of viscosity index improver was added to the mineral oil to raise it to 5 mm<sup>2</sup>/s at 100 degrees Celsius from the initial viscosity. Therefore, absent evidence to the contrary, it would have been obvious to one of ordinary skill at the time of the invention for the initial kinematic viscosity of the mineral oil to also overlap the instant claims since a sufficient amount of viscosity index improver is added to the oil to increase the kinematic to 5 mm<sup>2</sup>/s at 100 degrees Celsius.

Komiya discloses a lubricating composition comprised of mineral oil, including paraffinic and naphthenic mineral oils ([0002], 0012], [0016]). The disclosed mineral oil has a kinematic viscosity of 1 to 4 mm<sup>2</sup>/s, which clearly overlaps the instant claims ([0014]). Additionally, the % Cp of the oil is disclosed as 70 or higher as defined by ASTM D 3238 ([0012]). It is the examiner's position that the transmission oils disclosed by Carrick and Komiya both contain similar mineral oils, paraffinic and naphthenic oils at the same viscosity, and would therefore display the same characteristics. Komiya specifically uses mineral oil with a % Cp from 75 to 81 since base oil in this range of %

Cp displays excellent low temperature fluidity (Table 1, page 8, [0013]). Therefore, it would have been obvious to one of ordinary skill at the time of the invention for the transmission disclosed by Carrick to comprise a base mineral oil having a % Cp from 75-81 for the advantages of enhanced low temperature fluidity as taught by Komiya.

### ***Response to Arguments***

4. Applicant's arguments, filed 01/17/2008, with respect to the claim objections have been fully considered and are persuasive. The objections have been withdrawn.
5. Applicant's arguments, filed 01/17/2008, with respect to Tersigni in view of Komiya and Yagishita have been fully considered and are persuasive. The rejection has been withdrawn since Yagishita does not teach a sulfur containing compound as the instantly claimed compound (D).
6. Applicant's arguments filed 01/17/2008 with respect to Carrick in view of Komiya have been fully considered but they are not persuasive.

Specifically, applicant argues (A) that Carrick teaches an alkali or alkaline earth metal salt of a saligenin derivative as a critical component so that Carrick does not overlap the instantly claimed "consisting essentially of" language.

With respect to argument (A), the language "consisting essentially of" limits the scope of a claim to the specified materials or steps "and those that do not materially affect the basic and novel characteristic(s)" of the claimed invention. For the purposes

of searching for and applying prior art under 35 U.S.C. 102 and 103, absent a clear indication in the specification or claims of what the basic and novel characteristics actually are, "consisting essentially of" will be construed as equivalent to "comprising." See, e.g., *PPG*, 156 F.3d at 1355, 48 USPQ2d at 1355. If an applicant contends that additional steps or materials in the prior art are excluded by the recitation of "consisting essentially of," applicant has the burden of showing that the introduction of additional steps or components would materially change the characteristics of applicant's invention. *In re De Lajarte*, 337 F.2d 870, 143 USPQ 256 (CCPA 1964).

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amy Lang whose telephone number is (571) 272-9057. The examiner can normally be reached on Monday - Friday, 8:30 a.m. - 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Todd Manahan can be reached on 571-272-4713. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

04/01/2008  
/Amy T Lang/  
Examiner, Art Unit 3731

/Todd E Manahan/  
Supervisory Patent Examiner, Art Unit 3731